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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/025,211 | 12/19/2001 | Douglas E. Clark | 3156.1000-002 | 5174 |
| 28120 | 7590 | 03/02/2004 | EXAMINER | |
| ROPEs & GRAY LLP ONE INTERNATIONAL PLACE BOSTON, MA 02110-2624 | | | KAVANAUGH, JOHN T | |
| | | ART UNIT | PAPER NUMBER | |
| | | 3728 | | |

DATE MAILED: 03/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-----------------|--------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/025,211 | CLARK ET AL. |
| | Examiner | Art Unit |
| | Ted Kavanaugh | 3728 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06 February 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,13-18,20,21,23-32,37-39,41,51 and 58 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,4-12,19,22,33-36,40,42-50,52-57 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Feb. 6, 2004 has been entered.

Election/Restrictions

1. Claims 2,3,13-18,20-21,23-32,37-39,41,51,58 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 11. Claims 20-21, 23-32 and 37-39 have been included above. As applicant explains claims 20-21 are shown in figure 27B (a non-elected embodiment) and claims 23 and 37 as now amended (i.e. "tailored zones joined by a transition zone comprising material from each adjacent one of the tailored zones" read on the embodiment shown in figure 15E and 15F (a non-elected embodiment).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1,4-10,12,40,42-46,48,49,50,52-57 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6519876 (Geer et al).

Geer teaches a shoe with expansion mechanisms (see col. 29, line 65 to col. 31, line 30) substantially as claimed including a bottom (the outsole as best shown in figures 76 and 77) having an expansion mechanism (7500, 7600,7602) having a plurality of slots (best shown in figure 72A) extending laterally and longitudinally, an upper (see figures 70 and 72) having expansion mechanism (7004,7102) wherein mechanism 7102 has a plurality of slots (best shown in figure 72A), a chassis (midsole) having an upper contoured surface (see figure2), a heel cup (see figure 2) and at least three tailors zones. Geer teaches a number of different embodiments of midsole, each of the midsoles extends under the entire foot and therefore have at least three zones (i.e. the heel, the metatarsal and the toe) as claimed. Moreover, the midsole as shown and described in figure 13 and col. 15, line 64 to col. 16, line 6 can have inserts (zones) provided for the heel, shank (arch), and forefoot (toes) areas. Regarding claims 6 and 43, Geer teaches the upper can be made out of leather (see col. 10, lines 20-28), and see figure 70 which shows flexible material (7004) interposed between two pieces of the upper (leather upper) at a seam (stitching as shown in figure 70). Regarding claims 7 and 44, the seam is inherently an omega seam. Regarding the waterproof, breathable

liner, Geer teaches these features, see col. 10, lines 30-39, col. 23, lines 48-51 and col. 24, line 66 to col. 25, line 5. Regarding claims 50 and 57, see figure 72A which show the grooves/slots angles outwardly. When a foot is placed within the shoe, the shoe will encounter a force applied perpendicular to the bottom at the expansion mechanism and will create a lateral force.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 11,19,22 and 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geer in view of US 5566475 (Donnadieu).

Geer teaches a shoe substantially as claimed (see the rejection above) except for a liner having an expandable region and a non-expandable region. Geer teaches the upper may have other layers of materials that are waterproof and breathable and therefore teaches providing a waterproof liner, see col. 10, lines 20-39. Donnadieu teaches a liner for a shoe comprising an expandable region in the metatarsal and toe zones (11) and a non-expandable region in the heel zone (13), see col. 4, lines 34-35. It would have been obvious to provide the shoe of Geer with a liner having a stretchable and non-stretchable zones, as taught by Donnadieu, to ensure good heel retention.

When a foot is placed within the shoe, the shoe will encounter a force applied perpendicular to the bottom at the expansion mechanism and will create a lateral force.

6. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sacre '810 in view of US 5566475 (Donnadieu).

Sacre teaches a shoe substantially as claimed including a bottom (12), an upper (10), a chassis (14), a waterproof breathable liner (32) and a waterproof gasket (55) substantially as claimed except for a liner having at least one stretchable region. Donnadieu teaches a liner for a shoe comprising an expandable region in the metatarsal and toe zones (11) and a non-expandable region in the heel zone (13), see col. 4, lines 34-35. It would have been obvious to provide the shoe of Sacre with a liner having a stretchable region, as taught by Donnadieu, to ensure good heel retention. Regarding the terms "slip-lasted" and "cement lasted", the method of forming the device (i.e. slip lasted and cement lasted) is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight. It is well settled that the patentability of a product ordinarily cannot depend on its method of being made. See In re Thorpe, 777 F.2d 695, 227 USPQ 964 (1985).

Response to Arguments

7. Applicant's arguments filed Feb. 6, 2004 have been fully considered but they are not persuasive.

Applicant argues that "Geer may show sole that can expand, the Geer patent does not teach or suggest a shoe having the reactive expansion mechanism as claimed".

In response, applicant's hasn't shown any support in the Geer patent for support of his argument. During the interview applicant presented more argument but they haven't been included in this response.

Applicant argues "the processes of slip-lasting and cement lasting refer not just to processes but to the structure of shoes resulting from those processes, and thus constitute a structural limitation on the claimed invention. When combined, these processes result in a unique structure having a flexible (i.e. slip lasted) fore-foot part and a stiff (i.e. cement lasted) back part providing improved comfort and flexibility in the fore part while helping to maintain stability in the back part.

In response, applicant should put these structure limitations and functional language in the claimed. The examiner doesn't see any support in the specification or in applicant's remarks about these limitations encompass this structure. Applicant has a statement now but it still is not clear what structure applicant intends for it to encompass. Applicant should make it clear of record. Moreover, applicant is required to show support for this in the disclosure. Note, no new matter will be permitted.

Conclusion

8. **Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including:**

-"The reply must present arguments pointing out the *specific* distinctions believed to render the claims, including any newly presented claims, patentable over any applied references."

--“A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.”

-Moreover, “The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06” MPEP 714.02. The “disclosure” includes the claims, the specification and the drawings.

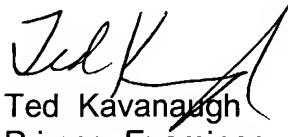
9. Information about your application can be obtained at the PTO Home Page at www.uspto.gov. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Telephone inquiries regarding other general questions, by persons entitled to the information, “should be directed to the group clerical personnel and not to the examiners” M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (703) 872-9306 (FORMAL FAXES ONLY). Applicants who authorize charges to a PTO deposit account may also use it for filing papers that require a fee. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email CustomerService3700@uspto.gov.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (703) 308-1244. The examiner can normally be reached from 6AM - 4PM.



Ted Kavanaugh
Primary Examiner
Art Unit 3728

TK
March 1, 2004